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RPP:156B US

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Yasmin Thanavala, et al.	Art Unit:	1651
Serial No:	09/464,416		
Filed:	December 16, 1999		
Examiner:	M. Flood		
For:	ORAL IMMUNOLOGY USING PLANT PRODUCT CONTAINING CONTAINING A NON- ENTERIC PATHOGEN ANTIGEN		

I certify that this Reply Brief is being deposited on November 5, 2001 with the U.S. Postal Service as first class mail addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231

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REPLY BRIEF

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Sir:

The attorney for the Appellants considers that most arguments showing patentability of the claims have already been set forth in the Appeal Brief.

We do, however, wish to point out the Examiner's rejections are inconsistent on their face.

In attempting to support the art rejection under 35 USC 103, the Examiner on page 10 of the Answer says:

> "Thus, one would have had a reasonable expectation of success to provide a therapeutic regimen such as the one in the claimed invention because the determination of an effective treatment method for providing an immune response by the oral ingestion of the claim-designated drug in combination with an orally effective adjuvant in an individual which was greater than the response elicited by the NEPA alone would have been a matter of routine optimization to one of ordinary skill in the art at the time the invention was made."

This statement (admission) is made by the Examiner based upon the Examiner's view of the cited art alone without consideration of the teachings in the current specification which is the only true teaching and suggestion of "a method for providing a specific immune response by feeding a mammal with genetically altered potato expressing a NEPA with an adjuvant", (see Examiner's Answer page 8, lines 13-16).

The Examiner's statement on page 10 of the Examiner's Answer is completely inconsistent with the statement by the Examiner on page 5 used to support the Examiner's 35 USC 112 rejection, i.e., "However, the specification does not provide sufficient guidance as to how one of ordinary skill in the art would provide an immune response in a mammal and/or a human to a NEPA other than the non-enteric pathogen antigen, hepatitis B surface antigen."

The Examiner's Answer thus says on page 10 that the state of the art alone is sufficient to reduce the claimed invention to practice as "a matter of routine optimization", but the added detail and specific teachings of the specification to the known state of the art somehow "does not provide sufficient guidance". The inconsistency is clear.

Both the 35 USC 112 and 35 USC 103 rejections should be reversed and the claims should be allowed.

Respectfully submitted,

Dated: November 5, 2001

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(1) Transmittal Form
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